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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/502,252	10/20/2004	Eivind Olav Andersen	TS9284 US	3944

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03/30/2005

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EXAMINER	
HUANG, MEI QI	
ART UNIT	PAPER NUMBER

1713

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/502,252

Applicant(s)

ANDERSEN, EIVIND OLAV

Examiner

Mei Q. Huang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-3 is/are rejected.
7) ☒ Claim(s) 4-10 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 07/22/04, 10/20/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 7, line 11, "ethylene bis-steramaide" is believed to be a typo. It should be changed to "ethylene bis-stearamide". Appropriate correction is required.

Claim Objections

2. Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim 3. See MPEP § 608.01(n). Accordingly, the claims 4-10 are not been further treated on the merits.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Syrier et al. (US Pat. 4,629,754) in view of Dempsey et al. (WO00/73378).

The prior art to Syrier et al. discloses a binder composition which is pigmentable comprising mineral lubricating oil extract, a petroleum resin and/or coumarone-indene resin, characterized in that the petroleum resin and /or coumarone-indene resin contains moieties derived from carboxylic acid, carboxylic acid anhydride or hydroxyl groups (Abstract). Syrier et al. are silent as of including an amide additive in the pigmentable binder composition. The prior art to Dempsey et al. discloses a mixture comprising a bitumen composition wherein the formulation of the bitumen includes a polymer and 0.05% to 10% of an amide additive that is predominately an amide having the formula:

$R_1\text{-CO-NH-(CH}_2\text{)}_x\text{-NH-CO-R}_2$ (Note, the formula is corrected by the examiner)

wherein R_1 and R_2 are alkyl groups, each having from 12 to 52 carbon atoms, and x is an integer of from 1 to 4 (Abstract) and said amide additive is ethylene bis-stearamide (page 13, Claim 6). Dempsey et al. further teach that asphalt binders containing the invented mixture can have significant lower viscosity at process and lower handling temperatures than polymer systems not containing the amide additive, this feature allows to lower temperatures for plant storage, pumping, and field mixing, and this characteristic could result in appreciable savings in energy requirements (page 5, line 9-13). Dempsey et al. herein explicitly disclose the benefits of including the amide additive in the bitumen composition. Accordingly, it would have been obvious to

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one having ordinary skill in the art at the time the invention was made to incorporate the amide additive, as taught by Dempsey et al., in Syrier et als' formulation for the pigmentable binder composition, in order to take advantages of lowering temperatures for field mixing, material transfer, and plant storage therefrom obtain savings in energy requirements, as taught by Dempsey et al. (page 5, line 9-13). With regard to the limitation of the pigmentable binder composition for use in synthetic asphalt, Syrier et al. disclose that their binder compositions are light-colored and therefore pigmentable, so that the ultimate mineral aggregate-, filler-, or pigment-containing asphaltic composition can be used for marking purposes by means of colored overlays over asphaltic concrete base courses of roads (column1, line14-19), which reads on applicant's limitation for the composition's use.

As to Claim 2, Syrier et als' formulation for the pigmentable binder composition can include more than one resins (Abstract), which suggests another polymer can be included.

Also, as to Claim 2, Dempsey et al. admit that, in order to meet the specific temperature requirement, the properties of conventional bitumen compositions can be modified by the addition of polymers and a wide variety of polymers have been used as additives in bitumen compositions, such as copolymers derived from styrene and conjugated dienes. (page 1, line 15-13 and page 2, line 1-12). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate another polymer, as taught by Dempsey et al, in Syrier et als'

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formulation for the pigmentable binder composition in order to meet the temperature requirement, as taught by Dempsey et al. (page 1, line 15-13 and page 2, line 1-12).

As to Claim 3, Syrier et al teach that the petroleum resins, one of the components of the pigmentable binder composition, are obtained by treating the resins with unsaturated carboxylic acids or anhydrides and the modified petroleum resins may have acid values of 1-100 mg KOH/g (column 2, line 41-59), which is within applicant's range, i.e. 0.5-200 mg KOH/g.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mei Q. Huang whose telephone number is (571) 272-3549. The examiner can normally be reached on 8am - 4pm, Mon. - Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner

March 25, 2005